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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,118	08/08/2003	Brian Dorricott	28489/39573	3822
4743	7590	12/28/2007	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			CHEEMA, UMAR	
		ART UNIT	PAPER NUMBER	
		2144		
		MAIL DATE	DELIVERY MODE	
		12/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/637,118	DORRICOTT, BRIAN
	Examiner	Art Unit
	Umar Cheema	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 December 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 11-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 May 2007 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. This action is response to Request for Continued Examination (RCE) Transmittal filed on 03 December 2007. Claims 1-5 and 11-22 are pending with claims 1, 21 and 22 being the independent claims. Claims 1, 21 and 22 have been amended. Claims 6-10 have been cancelled.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification fails to provide antecedent basis for an apparatus and a computer program product for transferring users email accounts.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Software, per se:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatu-

tory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

EXAMPLES:

1. A computer program product for....
2. A program which...

Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Claims are directed to an apparatus and a computer program product for transferring user's email accounts which are directed to software, *per se* and therefore are non-statutory subject matter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. **Claims 1-5, 11-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux et al (Giroux) (US 6,782,003) in view of Greenspan et al (Greenspan) (US 6,850,484).

Regarding claim 1, Giroux discloses a method of transferring users' email accounts (see col. 5, lines 14-16; transferring an email account from one ASP to another) from a source server to a destination server (see abstract; replicating date from source to destination), the method comprising: setting up the destination server to act as a gateway transferring e-mail connections to the source server each e-mail account having associated log on details; and when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the first time, setting up the destination server to automatically collect the associated log on details entered by the user (see col. 10, lines 44-50; automatically log) and to initiate the transfer of the user's mail folder and its contents from the source server to the destination server (see fig. 4b(450), col. 6, lines 57-63).

Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said setting up destination server to act as a gateway and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the same field of endeavor Greenspan discloses the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (see abstract; col. 2, lines 55-60; a request for information found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server). Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. Motivation for doing so would have been because gateway is a common protocol used for a software or hardware communications.

Regarding **claim 2**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 1, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).

Regarding **claim 3**, Giroux discloses a method as claimed in claim 2, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).

Regarding **claims 4-5**, the combination of Giroux and Greenspan disclose a method as claimed in claim 1, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 4, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claims 6-10** (Cancelled).

Regarding **claim 11**, Giroux discloses a method as claimed in claim 1, further comprising initiating the transfer of the user's mail folder when each user logs on for the first time before the destination server services the user (see col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

Regarding **claim 12**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 11, wherein setting up the destination server comprises allocating the destination server the same IP address as

the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).

Regarding **claim 13**, Giroux discloses a method as claimed in claim 12, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).

Regarding **claims 14-15**, the combination of Giroux and Greenspan disclose a method as claimed in claim 11, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 14, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claim 16**, Giroux discloses a method as claimed in claim 1, further comprising: causing the destination server to pass the e-mail connection through to the source server when each user logs on for the first time; and transferring the user's mail folder once the user has logged off (see col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

Regarding **claim 17**, the combination of Giroux and Greenspan disclose wherein Greenspan further discloses a method as claimed in claim 16, wherein setting up the

destination server comprises allocating the destination server the same IP address as the source server (see col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (see col. 3, lines 5-10).

Regarding **claim 18**, Giroux discloses a method as claimed in claim 17, further comprising retiring the source server once all e-mail accounts have been transferred (see fig. 4a, col. 6, lines 12-15).

Regarding **claims 19-20**, the combination of Giroux and Greenspan disclose a method as claimed in claim 16, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (see Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 19, further comprising retiring the source server once all e-mail accounts have been transferred (see Giroux: fig. 4a, col. 6, lines 12-15).

Regarding **claim 21**, Giroux discloses an apparatus for transferring users' e-mail accounts (see col. 5, lines 14-16; transferring an email account from one ASP to another) from a source server to a destination server (see abstract; replicating date from source to destination), the apparatus comprising:
a source server on which is set up the e-mail accounts, each e-mail account having associated log on details (see col. 3, lines 30-35; col. 5, lines 51-55; account identification and password) ; and a destination server arranged to receive e-mail

accounts as they are transferred from the source server (see abstract, col. 3, lines 30-35), arranged as a gateway transferring e-mail connections to the source server, and further arranged such that, when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the first time, it automatically collects the associated log on details entered by the user (col. 10, lines 44-50; automatically log) and initiates the transfer of the user's mail folder and its contents from the source server to the destination server (fig. 4b(450), col. 6, lines 57-63).

Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said gateway transferring e-mail connections and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the same field of endeavor Greenspan discloses a system manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers, and the stream manager is linked to a packet network, such as the internet (see abstract; col. 2, lines 55-60; a request for information found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server). Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts

as a gateway. Motivation for doing so would have been because gateway is a common protocol used for a software or hardware communications.

Regarding **claim 22** Giroux discloses a computer program product (col. 7, Software Architecture) for transferring users' e-mail accounts from a source server to a destination server (see col. 5, lines 14-16; transferring an email account from one ASP to another), each e-mail account having associated log on details, the computer program product comprising a computer readable program code configured to cause the destination server to act as a gateway transferring e-mail connections to the source server (see abstract, fig. 4a-b, col. 7, lines 10-13; transferring email accounts), and, when the user logs on to one of the e-mail accounts using the associated log on details via the destination server for the first time, to cause the destination server to automatically collect the associated log on details entered by the user (col. 10, lines 44-50; automatically log) and to initiate the transfer of the user's mail folder and its contents from the source server to the destination server (fig. 4b(450), col. 6, lines 57-63).

Giroux discloses substantially the invention as claimed above for the given reason however does not disclose wherein said setting up destination server to act as a gateway and each email account having associated log on details wherein one of the email account having associated log on details via the destination server. However in the same field of endeavor Greenspan discloses the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (see abstract; col. 2, lines 55-60; a request for information

found over a packet network at a destination formulated by a gateway server) and each email account having associated log on details wherein one of the email account having associated log on details via the destination server (see col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server). Therefore, it would have been obvious to one of ordinary skill person in the art of networking at the time of the invention to combine the teaching of Giroux and teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. Motivation for doing so would have been because gateway is a common protocol used in any software or hardware communications.

Response to Arguments

4. Applicant's arguments filed December 03, 2007 with respect to claims 1-5 and 11-22 have been fully considered but they are not persuasive.

Applicant argues, see remarks, filed 12/03/2007, "none of claims 1-5 or 11-22 are rendered unpatentable over Giroux et al. in view of Greenspan et al., because neither Giroux et al. nor Greenspan et al. disclose automatically collecting log on details entered by the user and initiating the transfer of the user's mail folder and its contents from the source server to the destination server, when the user log on to the email account via the destination server for the first time using the associated log on details of the email account as used with the source server."

In response to the preceding argument, Examiner respectfully refers that Giroux and Greenspan do disclose automatically collecting information entered by the user at logon (see Giroux: col. 10, lines 44-50; automatically log) and initiating the transfer of the user's mail folder and its contents from the source server to the destination server (see fig. 4b(450), col. 6, lines 57-63), when the user log on to the email account via the destination server for the first time using the associated log on details of the email account as used with the source server (see Greenspan: col. 2, lines 60-67, col. 3, lines 1-5; IP addresses associated with user's server and destination server).

Likewise, Greenspan also discloses automatically collecting information entered by the user at logon and initiating the transfer of the user's mail folder and its contents from the source server to the destination server (see col. 3, lines 2-5; the destination server may respond automatically, may store the received message, or may forward the message).

Therefore, the combination of Giroux and Greenspan does disclose or suggest all of the limitations of claims 1-5 and 11-22 for the given reason above.

Examiner's Note: Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of References Cited) for a list of more relevant prior arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Cheema whose telephone number is 571-270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn, Jr. can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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